UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,180	11/05/2003	Michael Raley	111325-500100	6377

22204   7590   05/13/2009
NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER
DISTEFANO, GREGORY A

ART UNIT	PAPER NUMBER
2175	

MAIL DATE	DELIVERY MODE
05/13/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2009*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,10-12,14-16,20,21,24,25 and 79-101* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1,3,10-12,14-16,20,21,24,25 and 79-101* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *05 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
       Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
       Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the amendment filed on 2/27/2009.

2.   Claims 1, 3, 10-12, 14-16, 20, 21, 24, 25, and 79-101 are currently pending.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

2/27/2009 has been entered.

Specification

4.   The specification is objected to for failing to provide proper support for the claims.

Claims 25 and 90 recite the limitations of "*playing the selected audio content on the*

content consumption device on a portion of the available audio output channel and

playing preferred content on the content consumption device on a remaining portion of

the available audio output channel" which is not sufficiently described within applicant's

specification. Applicant describes their use of portions of channels on pages 5-6 and

paragraphs [0020]-[0021] of their specification. While applicant describes

simultaneously <u>displaying</u> preferred and selected content on one video channel and

displaying selected content on one of a video or audio channel and preferred content on

the other, applicant never describes how two separate contents may be played on a

single audio channel.

Claim Objections

5.   Claims 25 and 90 are objected to because of the following informalities: The

claims contain the limitation of "*the audio output channel is not free*". As claims 1 and

79, from which claims 25 and 90 depend, refer to the channel as being "available", it is

recommended that claim 25 be amended to contain similar terminology, e.g. "not

available". Appropriate correction is required.

6.   Claim 95 is objected to because of the following informalities: claim 95 refers to

"the user preference" which is note recited in its current parent claim of 91. For this

reason, the examiner assumes that claim 95 was intended to be dependent upon claim

94, as claim 94 refers to "determining a preference of a user". Appropriate correction is

required.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

8.   Claims 25 and 90 rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The claims recite the limitation of "*playing the*

selected audio content on the content consumption device on a portion of the available

audio output channel and playing preferred content on the content consumption device

on a remaining portion of the available audio output channel". Applicant's specification

fails to define what applicant intends by such a limitation. The closest support for this

limitation may possibly be found in applicant's specification on pages 5-6, paragraphs

[0020]-[0021], where they describe <u>displaying</u> preferred and selected content on one

channel, but make no mention of <u>playing two separate</u> audio contents on a single

channel, therefore this limitation is vague and unclear.

Claim Rejections - 35 USC § 101

9.   The previous rejections of claims 26-28, 54-60, and 62-78 under 35 U.S.C. 101

are hereby withdrawn due to applicants 2/27/2009 amendment.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11.   Claims 79, 81, 84, and 85 are rejected under 35 U.S.C. 102(e) as being

anticipated by Thomas et al. (US 2003/0037068), hereinafter Thomas.

12.   As per claim 79, Thomas teaches the following:

detecting a pause action performed by the content consumption device during

rendering of preferred content that makes available the audio output channel of the

content consumption device by the performing of the pause action, (abstract), i.e. if the

user **pauses** real-time media or near video-on-demand media, the interactive media

application may store the media. The interactive media application may also provide

the user with the ability to rewind, resume play of, and fast-forward the media;

selecting audio content to be played on the content consumption device on the

available audio output channel based on an automated algorithm that selects audio

content to be played from a repository of audio content, (abstract), i.e. the pause-time

content may be audio or video media and may be an advertisement, trivia, program

summaries or any other suitable pause-time content. The interactive media application

may provide customized pause-time content specific to the user or specific to the media

paused by using media data associated with the media, (pg. 2, paragraph [0023]), i.e.

main facility 34 may also store and distribute pause-time content, which may be media,

media data, or both;

The examiner interprets Thomas's method of customizing content using specific

variables to encompass applicant's "automated algorithm"; and

playing the selected audio content on the content consumption device on the

available audio output channel simultaneously with the preferred content during the

performing of the pause action, (abstract), i.e. the pause-time content may be audio or

video media and may be an advertisement, trivia, program summaries or any other

suitable pause-time content.

The examiner would like to note that as the advertisement of Thomas may be

purely audio, it would have been clear to one of ordinary skill in the art that the paused

content may still be displayed as the advertisement is only utilizing the audio channel.

13.   Regarding claim 81, Thomas teaches the method of claim 79 as described

above. Thomas further teaches the following:

the selected audio content is a personal message, (abstract), i.e. the pause-time

content <u>may be audio</u> or video media and may be an advertisement, trivia, program

summaries <u>or any other suitable pause-time content</u>. The interactive media application

may provide <u>customized pause-time content specific to the user</u> or specific to the media

paused by using media data associated with the media.

The examiner would like to further note that applicant's "personalized message"

clearly fails under Thomas's description of "suitable pause-time content" and

"customized content specific to the user".

14.   Regarding claim 84, Thomas teaches the method of claim 79 as described

above. Thomas further teaches the following:

providing software code in the content consumption device for causing the

playing of the selected audio content, (see pg. 2, paragraph [0029]).

15.   Regarding claim 85, Thomas teaches the method of claim 79 as described

above. Thomas further teaches the following:

> *providing software code in a medium used by the content consumption device for*

causing the playing of the selected audio content, (see pg. 2, paragraph [0029]).

16.   Regarding claim 86, Thomas teaches the method of claim 79 as described

above. Thomas further teaches the following:

> *transmitting a signal to the content consumption device for causing the playing of*

the selected audio content, (pg. 7, paragraph [0068]), i.e. at step 620, the interactive

media application may substitute pause-time content in place of the paused VOD or

recorded media that is currently playing.

The examiner would like to further note that in order for Thomas's device to play

pause-time content, it would first have to receive a signal to do so, such as receiving the

pause command from the user.

17.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18.   Claims 91, 97 and 98 are rejected under 35 U.S.C. 102(b) as being anticipated

by Weisberg et al. (US 6,351,736), hereinafter Weisberg.

19.   As per claim 91, Weisberg teaches the following:

detecting a radio mode action performed by the content consumption device

during rendering of preferred content that makes available the video output channel of

the content consumption device by the performing of the radio mode action, (abstract),

i.e. a method and system for playing a first type of data, such as audio stream data, for

the user;

selecting video content to be played on the content consumption device on the

available video output channel based on an automated algorithm that selects video

content to be played from a repository of video content, (abstract), i.e. a method and

system for playing a first type of data, such as audio stream data, for the user while

simultaneously displaying an advertisement in the form of a second type of data, such

as video data, (column 6, lines 3-5), i.e. advertisement management module first selects

the advertisement, for example according to the content of the audio data, (column 6,

lines 20-22), i.e. the audio files and the advertisements may be retrieved from different

server computers; and

playing the selected video content on the content consumption device on the

available video output channel simultaneously with the preferred content during the

performing of the radio mode action, (abstract), i.e. a method and system for playing a

first type of data, such as audio stream data, for the user while simultaneously

displaying an advertisement in the form of a second type of data, such as video data.

20.   Regarding claim 97, Weisberg teaches the method of claim 91 as described

above. Weisberg further teaches the following:

providing software code in a medium used by the content consumption device for

causing the playing of the selected video content, (column 5, lines 56-58), i.e.

advertisement module 20 features a video display module 26 which drives the display of

the video data on display screen 22 by communicating with video card 24. Video

display module 26 is preferably implemented as a video codec software program.

21.   Regarding claim 98, Weisberg teaches the method of claim 91 as described

above. Weisberg further teaches the following:

transmitting a signal to the content consumption device for causing the playing of

the selected video content, (column 5, lines 56-58), i.e. advertisement module 20

features a video display module 26 which drives the display of the video data on display

screen 22 by communicating with video card 24. Video display module 26 is preferably

implemented as a video codec software program.

Claim Rejections - 35 USC § 103

22.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

23.   Claims 1, 10, and 14-16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Thomas, in view of Nishio (GB 2,302,635 A).

24.   As per claim 1, Thomas teaches the following:

       detecting an action performed by the content consumption device during

rendering of the preferred content that makes available the audio output channel of the

content consumption device by the performing of the fast forward action, (abstract), i.e.

if the user pauses real-time media or near video-on-demand media, the interactive

media application may store the media. The interactive media application may also

provide the user with the ability to rewind, resume play of, and fast-forward the media;

       selecting audio content to be played on the content consumption device on the

available audio output channel based on an automated algorithm that selects audio

content to be played from a repository of targeted audio content, (abstract), i.e. the

pause-time content may be audio or video media and may be an advertisement, trivia,

program summaries or any other suitable pause-time content. The interactive media

application may provide customized pause-time content specific to the user or specific

to the media paused by using media data associated with the media, (pg. 2, paragraph

[0023]), i.e. main facility 34 may also store and distribute pause-time content, which

may be media, media data, or both;

       The examiner interprets Thomas's method of customizing content using specific

variables to encompass applicant's "automated algorithm".

playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action, (abstract), i.e. the pause-time content may be audio or video media and may be an advertisement, trivia, program summaries or any other suitable pause-time content.

The examiner would like to note that as the advertisement of Thomas may be purely audio, it would have been clear to one of ordinary skill in the art that the paused content may still be displayed as the advertisement is only utilizing the audio channel.

However, Thomas does not explicitly teach a method where the action performed is that of a fast forward action. Nishio teaches the following:

detecting a fast forward action performed by the content consumption device during rendering of the preferred content, (abstract), i.e. a special video program, such as an advert or commercial video program, is transmitted from a special video storage unit 41 of the video server to each subscriber terminal within a nontransmission time which takes place during a searching time for a video program requested by the subscriber and/or during an execution time of a specific reproduction control command, such as a "fast-forward" command or a "fast-rewind" command.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the action of Thomas with the fast-forward action of Nishio. One of ordinary skill in the art would have been motivated to have made such modifications because both Thomas and Nishio are analogous art in the field of presenting advertisements to a user while a viewing action is being performed.

Furthermore, as was well known in the art at the time the invention was made, both

actions of performing a pause action or a fast-forward action make available the audio

channel.

25.   Regarding claim 10, modified Thomas teaches the method of claim 1 as

described above. Thomas further teaches the following:

    the selected audio content is a personal message, (abstract), i.e. the pause-time

content <u>may be audio</u> or video media and may be an advertisement, trivia, program

summaries <u>or any other suitable pause-time content</u>. The interactive media application

may provide <u>customized pause-time content specific to the user</u> or specific to the media

paused by using media data associated with the media.

26.   Regarding claim 14, modified Thomas teaches the method of claim 1 as

described above. Thomas further teaches the following:

    providing software code in the content consumption device for causing the

playing of the selected audio content, (see pg. 2, paragraph [0029]).

27.   Regarding claim 15, modified Thomas teaches the method of claim 1 as

described above. Thomas further teaches the following:

    providing software code in a medium used by the content consumption device for

causing the playing of the selected audio content, (see pg. 2, paragraph [0029]).

28.   Regarding claim 16, modified Thomas teaches the method of claim 1 as

described above. Thomas further teaches the following:

   transmitting a signal to the content consumption device for causing the playing of

the selected audio content, (pg. 7, paragraph [0068]), i.e. at step 620, the interactive

media application may substitute pause-time content in place of the paused VOD or

recorded media that is currently playing.

   The examiner would like to further note that in order for Thomas's device to play

pause-time content, it would first have to receive a signal to do so, such as receiving the

pause command from the user.

29.   Claims 3, 11, 12, 20, 21, and 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Thomas in view of Nishio as applied to claim 1 above, and further in

view of Bacso et al. (US 2002/0124182), hereinafter Bacso.

30.   Regarding claim 3, modified Thomas teaches the method of claim 1 as described

above. However, Thomas does not explicitly teach a method of providing a benefit to a

user that plays the advertising content. Bacso teaches the following:

   providing a benefit to a user of the content consumption device in exchange for

playing the selected audio content, (pg. 7, paragraph [0129]), i.e. the selection of the

content alternatives, the selection and attribution of characteristics to opportunities and

content, the transmission mechanisms selected for the content and opportunities, and

the methods used for matching the content and opportunities can be based on yield

management methods, an example of which is optimal dynamic pricing.

It would have been obvious to one of ordinary skill in the art to have modified the

advertisements of Thomas with the dynamic pricing of Bacso. One of ordinary skill in

the art would have been motivated to have made such modifications because both

Thomas and Bacso are analogous art in the field of presenting advertisements to

television users. Furthermore, as Bacso describes in pg. 7, paragraph [0130] and

[0131], dynamic pricing both benefits the user and encourages an advertisement to be

viewed as end users would get the most up to date information up until the exploitation

of the advertisement opportunity.

31.   Regarding claim 11, modified Thomas teaches the method of claim 1 as

described above. However, Thomas does not explicitly teach a method of determining

user preferences and populating the repository with content based on the user

preferences. Bacso teaches the following:

determining a preference of a user of the content consumption device, wherein

the determined user preference includes at least one of a shopping preference, a show

preference, a purchase history, a music preference, and a video preference, (pg. 2,

paragraph [0041]), i.e. the matching process may have complex requirements including

multi-service broadcaster requirements, multi-message content sequencing, and user

preferences including ratings and permissions; and

populating the repository of audio content based upon the determined user

preference, (pg. 5, paragraph [0084]), i.e. Fig. A4 shows a list of content and related

characteristics. The content type 81 allows the receiver to determine if it is capable of

showing the content. The examiner interprets a list of content which may be displayed

under Bacso to encompass applicant's limitation.

It would have been obvious to one of ordinary skill in the art to have modified the

content of Thomas with the user preference based content of Bacso. One of ordinary

skill in the art would have been motivated to have made such modifications because

both Thomas and Bacso are analogous art in the field of presenting advertisements to

television users. Furthermore, as Bacso teaches in pg.1, paragraphs [0008] – [0022],

targeting advertising was already well known in the art. Still further, Thomas discusses

user preferences in page 5, paragraph [0050] and building a customized repository in

page 4, paragraph [0043].

32.   Regarding claim 12, modified Thomas teaches the method of claim 11 as

described above. Bacso further teaches the following:

playing the selected audio content based on the determined user preference,

(pg. 2, paragraph [0041]), i.e. presentation methods in the receiver <u>display the content</u>

<u>based on protocol</u>, format and opportunities created by function invocation by the user,

physical and temporal content availability, and processes for matching the content to

the opportunities.

33.   Regarding claim 20, modified Thomas teaches the method of claim 1 as

described above. However, Thomas does not explicitly teach a method of documenting

user actions. Bacso teaches the following:

message documenting the detected fast forward action, (pg. 8, paragraph

[0191]), i.e. the presentation method can also handle and manage user input to control

the triggering of functional opportunities. The logging of results can include <u>all inputs</u>

<u>from the user</u>.

It would have been obvious to one of ordinary skill in the art to have modified the

user inputs of Thomas with the input logging of Bacso. One of ordinary skill in the art

would have been motivated to have made such modifications because both Thomas

and Bacso are analogous art in the field of presenting advertisements to television

users. Furthermore, such input logging would allow (Bacso, pg. 8, paragraph [0191]),

"these inputs can be processed within the receiver or at a network site to as part of <u>the</u>

<u>analysis of viewing habits</u>".

34.   Regarding claim 21, modified Thomas teaches the method of claim 20 as

described above. Nishio further teaches the following:

the detected fast forward action includes skipping of a commercial being played

on the content consumption device, (pg. 4, 2nd paragraph), i.e. it is possible for each

subscriber <u>to skip</u> or neglect such <u>an advertisement or commercial video program</u> by

the use of such a reproduction control command.

35.   Regarding claim 24, modified Thomas teaches the method of claim 1 as described above. However, Thomas does not explicitly teach a method of where the content is labeled. Bacso teaches the following:

the selected audio content is labeled as at least one of audio content,

personalized advertisement audio content, and regional advertisement audio content,

(pg. 5, paragraph [0085]), i.e. the content characteristics 83 describe the contents targeting attributes. The number and types of characteristics are dynamic, and can grow or change over time.

As may be seen in Bacso's showing of Fig. A4, one of the "content characteristics" listed is "Area" which specifies the geographic region in which the ad is to be displayed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified the pause-time content of Thomas with the content labeling of Bacso. One of ordinary skill in the art would have been motivated to have made such modifications because both Thomas and Bacso are analogous art in the field of presenting advertisements to television users. Furthermore, Thomas teaches in page 4, paragraph [0042], that the pause-time content may be customized for certain aspects. One of ordinary skill in the art would have seen the benefit of labeling the substitute content to aid in customizing the substitute content to be displayed.

36.   Claims 25 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Thomas in view of Nishio as applied to claim 1 and Thomas as applied to claim 79

above, and further in view of Frerichs et al. (US 6,684,249), hereinafter Frerichs.

37.   Regarding claims 25 and 90, Modified Thomas teaches the methods of claims 1

and 79 as described above. However, neither Thomas nor Nishio explicitly teach a

method where the selected and preferred content are played on a single audio channel.

Frerichs teaches the following:

> *the audio output channel is not free, and further comprising:*

> *playing the selected audio content on the content consumption device on a*

portion of the available audio output channel, (column 2, lines 25-30), i.e. the method

also includes inserting an advertisement into the audio data; *and*

> *playing preferred content on the content consumption device on a remaining*

portion of the available audio output channel, (column 2, lines 25-30), i.e. the method

also includes inserting an advertisement into the audio data while simultaneously

reducing an audio volume level of the audio data and simultaneously outputting the

audio data and the advertisement where an advertisement volume level is selected for a

user to hear the advertisement while playing the audio data in a song format as

background noise.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have modified the audio advertising method of Thomas with the

audio overlay method of Frerichs. One of ordinary skill in the art would have been

motivated to have made such modifications because both Thomas and Frerichs are

analogous art in the field of providing audio advertisements during an on-demand type

service.

38.   Claims 80, 82, 83, and 87-89 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Thomas as applied to claim 79 above, in view of Bacso.

39.   Regarding claim 80, Thomas teaches the method of claim 79 as described

above. However, Thomas does not explicitly teach of providing a benefit to the user.

Bacso teaches the following:

providing a benefit to a user of the content consumption device in exchange for

playing the selected audio content, (pg. 7, paragraph [0129]), i.e. the selection of the

content alternatives, the selection and attribution of characteristics to opportunities and

content, the transmission mechanisms selected for the content and opportunities, and

the methods used for matching the content and opportunities can be based on yield

management methods, an example of which is optimal dynamic pricing.

It would have been obvious to one of ordinary skill in the art to have modified the

advertisements of Thomas with the dynamic pricing of Bacso. One of ordinary skill in

the art would have been motivated to have made such modifications because both

Thomas and Bacso are analogous art in the field of presenting advertisements to

television users. Furthermore, as Bacso describes in pg. 7, paragraph [0130] and

[0131], dynamic pricing both benefits the user and encourages an advertisement to be

viewed as end users would get the most up to date information up until the exploitation

of the advertisement opportunity.

40.   Regarding claim 82, Thomas teaches the method of claim 79 as described

above. However, Thomas does not explicitly teach a method of determining user

preferences and populating the repository with content based on the user preferences.

Bacso teaches the following:

determining a preference of a user of the content consumption device, wherein

the determined user preference includes at least one of a shopping preference, a show

preference, a purchase history, a music preference, and a video preference, (pg. 2,

paragraph [0041]), i.e. the matching process may have complex requirements including

multi-service broadcaster requirements, multi-message content sequencing, and <u>user</u>

<u>preferences including ratings and permissions</u>; and

populating the repository of audio content based upon the determined user

preference, (pg. 5, paragraph [0084]), i.e. Fig. A4 shows a list of content and related

characteristics. The content type 81 allows the receiver to determine if it is capable of

showing the content. The examiner interprets a list of content which may be displayed

under Bacso to encompass applicant's limitation.

It would have been obvious to one of ordinary skill in the art to have modified the

content of Thomas with the user preference based content of Bacso. One of ordinary

skill in the art would have been motivated to have made such modifications because

both Thomas and Bacso are analogous art in the field of presenting advertisements to

television users. Furthermore, as Bacso teaches in pg.1, paragraphs [0008] – [0022],

targeting advertising was already well known in the art. Still further, Thomas discusses

user preferences in page 5, paragraph [0050] and building a customized repository in

page 4, paragraph [0043].

41.   Regarding claim 83, modified Thomas teaches the method of claim 82 as

described above. Bacso further teaches the following:

playing the selected audio content based on the determined user preference,

(pg. 2, paragraph [0041]), i.e. presentation methods in the receiver <u>display the content</u>

<u>based on protocol</u>, format and opportunities created by function invocation by the user,

physical and temporal content availability, and processes for matching the content to

the opportunities.

42.   Regarding claim 87, Thomas teaches the method of claim 79 as described

above. However, Thomas does not explicitly teach a method of documenting user

actions. Bacso teaches the following:

message documenting the detected pause action, (pg. 8, paragraph [0191]), i.e.

the presentation method can also handle and manage user input to control the

triggering of functional opportunities. The logging of results can include <u>all inputs from</u>

<u>the user</u>.

It would have been obvious to one of ordinary skill in the art to have modified the

user inputs of Thomas with the input logging of Bacso. One of ordinary skill in the art

would have been motivated to have made such modifications because both Thomas

and Bacso are analogous art in the field of presenting advertisements to television

users. Furthermore, such input logging would allow (Bacso, pg. 8, paragraph [0191]),

"these inputs can be processed within the receiver or at a network site to as part of the

analysis of viewing habits".

43.   Regarding claim 88, modified Thomas teaches the method of claim 87 as

described above. Thomas further teaches the following:

    the detected pause action includes pausing of a commercial being played on the

content consumption device, (abstract), i.e. the user may pause media such as real-

time media, video-on-demand, or recorded media.

    As was well known at the time, all three of Thomas's example media (real-time,

video-on-demand, or recorded) could have included commercials and therefore the

commercials could have been paused while being played using Thomas's method.

44.   Regarding claim 89, Thomas teaches the method of claim 79 as described

above. However, Thomas does not explicitly teach a method of where the content is

labeled. Bacso teaches the following:

    distributing content to the content consumption device, including content that is at

least one of labeled as preferred audio content, labeled as personalized advertisement

audio content, and labeled as regional advertisement audio content, (pg. 5, paragraph

[0085]), i.e. the content characteristics 83 describe the contents targeting attributes.

The number and types of characteristics are dynamic, and can grow or change over time.

As may be seen in Bacso's showing of Fig. A4, one of the "content characteristics" listed is "Area" which specifies the geographic region in which the ad is to be displayed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified the pause-time content of Thomas with the content labeling of Bacso. One of ordinary skill in the art would have been motivated to have made such modifications because both Thomas and Bacso are analogous art in the field of presenting advertisements to television users. Furthermore, Thomas teaches in page 4, paragraph [0042], that the pause-time content may be customized for certain aspects. One of ordinary skill in the art would have seen the benefit of labeling the substitute content to aid in customizing the substitute content to be displayed.

45.   Claims 92, 94, 95, 96, 99, and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisberg as applied to claim 91 above, in view of Bacso.

46.   Regarding claim 92, Weisberg teaches the method of claim 91 as described above. However, Weisberg does not explicitly teach of providing a benefit to the user. Bacso teaches the following:

providing a benefit to a user of the content consumption device in exchange for

playing the selected video content, (pg. 7, paragraph [0129]), i.e. the selection of the

content alternatives, the selection and attribution of characteristics to opportunities and

content, the transmission mechanisms selected for the content and opportunities, and

the methods used for matching the content and opportunities can be based on yield

management methods, an example of which <u>is optimal dynamic pricing</u>.

It would have been obvious to one of ordinary skill in the art to have modified the

advertisements of Weisberg with the dynamic pricing of Bacso. One of ordinary skill in

the art would have been motivated to have made such modifications because both

Weisberg and Bacso are analogous art in the field of presenting advertisements to

users. Furthermore, as Bacso describes in pg. 7, paragraph [0130] and [0131],

dynamic pricing both benefits the user and encourages an advertisement to be viewed

as end users would get the most up to date information up until the exploitation of the

advertisement opportunity.

47.   Regarding claim 94, Weisberg teaches the method of claim 91 as described

above. However, Weisberg does not explicitly teach a method of determining user

preferences and populating the repository with content based on the user preferences.

Bacso teaches the following:

determining a preference of a user of the content consumption device, wherein

the determined user preference includes at least one of a shopping preference, a show

preference, a purchase history, a music preference, and a video preference, (pg. 2,

paragraph [0041]), i.e. the matching process may have complex requirements including

multi-service broadcaster requirements, multi-message content sequencing, and <u>user</u>

<u>preferences including ratings and permissions</u>; and

populating the repository of video content based upon the determined user

preference, (pg. 5, paragraph [0084]), i.e. Fig. A4 shows a list of content and related

characteristics. The content type 81 allows the receiver to determine if it is capable of

showing the content. The examiner interprets a list of content which may be displayed

under Bacso to encompass applicant's limitation.

It would have been obvious to one of ordinary skill in the art to have modified the

content of Weisberg with the user preference based content of Bacso. One of ordinary

skill in the art would have been motivated to have made such modifications because

both Weisberg and Bacso are analogous art in the field of presenting advertisements to

users. Furthermore, as Bacso teaches in pg.1, paragraphs [0008] – [0022], targeting

advertising was already well known in the art.

48.   Regarding claim 95, modified Weisberg teaches the method of claim **94** as

described above. Bacso further teaches the following:

playing the selected video content based on the determined user preference, (pg.

2, paragraph [0041]), i.e. presentation methods in the receiver <u>display the content</u>

<u>based on protocol</u>, format and opportunities created by function invocation by the user,

physical and temporal content availability, and processes for matching the content to

the opportunities.

49.   Regarding claim 96, modified Weisberg teaches the method of claim 94 as

described above. Weisberg further teaches the following:

providing software code in the content consumption device for causing the

playing of the selected video content, (column 2, lines 17-19), i.e. by "playing", it is

meant that the content of the data is presented to the user by a hardware device,

optionally in combination <u>with software</u>.

50.   Regarding claim 99, Weisberg teaches the method of claim 91 as described

above. However, Weisberg does not explicitly teach a method of documenting user

actions. Bacso teaches the following:

message documenting the detected radio mode action, (pg. 8, paragraph [0191]),

i.e. the presentation method can also handle and manage user input to control the

triggering of functional opportunities. The logging of results can include <u>all inputs from</u>

<u>the user</u>.

        It would have been obvious to one of ordinary skill in the art to have modified the

user inputs of Weisberg with the input logging of Bacso. One of ordinary skill in the art

would have been motivated to have made such modifications because both Weisberg

and Bacso are analogous art in the field of presenting advertisements to users.

Furthermore, such input logging would allow (Bacso, pg. 8, paragraph [0191]), "these

inputs can be processed within the receiver or at a network site to as part of <u>the</u>

<u>analysis of viewing habits</u>".

51.   Regarding claim 100, Weisberg teaches the method of claim 91 as described

above. However, Weisberg does not explicitly teach a method of where the content is

labeled. Bacso teaches the following:

distributing content to the content consumption device, including content that is at

least one of labeled as preferred video content, labeled as personalized advertisement

video content, and labeled as regional advertisement video content, (pg. 5, paragraph

[0085]), i.e. the content characteristics 83 describe the contents targeting attributes.

The number and types of characteristics are dynamic, and can grow or change over

time.

As may be seen in Bacso's showing of Fig. A4, one of the "content

characteristics" listed is "Area" which specifies the geographic region in which the ad is

to be displayed.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have further modified the ad content of Weisberg with the

content labeling of Bacso. One of ordinary skill in the art would have been motivated to

have made such modifications because both Weisberg and Bacso are analogous art in

the field of presenting advertisements to users.

52.   Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Weisberg as applied to claim 91 as described above, in view of Thomas

53.   Regarding claim 93, Weisberg teaches the method of claim 91 as described

above. However Weisberg does not explicitly teach that the selected content is a

personal message. Thomas further teaches the following:

the selected <u>audio</u> content is a personal message, (abstract), i.e. the pause-time

content may be audio or <u>video media</u> and may be an advertisement, trivia, program

summaries <u>or any other suitable pause-time content</u>. The interactive media application

may provide <u>customized pause-time content specific to the user</u> or specific to the media

paused by using media data associated with the media.

It would have been obvious to one of ordinary skill in the art to have modified the

video advertisements of Weisberg with the personal messages of Thomas. One of

ordinary skill in the art would have been motivated to have made such modifications

because both Weisberg and Thomas are analogous art in the field of presenting

advertisements to users.

54.   Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Weisberg as applied to claim 91 as described above, in view of Tsuchida et al. (US

2002/0194592), hereinafter Tsuchida.

55.   Regarding claim 101, Weisberg teaches the method of claim 91 as described

above. However, Weisberg doesn't explicitly teach a method where the preferred

content is displayed with the selected content. Tsuchida teaches the following:

the video output channel is not free, and further comprising:

playing the selected video content on the content consumption device on a

portion of the available video output channel, (pg. 2, paragraph [0031]), i.e. the

substitute content may be displayed as the main screen view, while the live or other

programming content is displayed as a picture-in-picture on the television screen; and

playing preferred content on the content consumption device on a remaining

portion of the available video output channel, (pg. 2, paragraph [0031]), i.e. the

substitute content may be displayed as the main screen view, while the live or other

programming content is displayed as a picture-in-picture on the television screen.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have modified the substitute content display of Weisburg with the

picture-in-picture method of Tsuchida. One of ordinary skill in the art would have been

motivated to have made such modifications because both Weisburg and Tsuchida are

analogous art in the field of displaying substitute content to the user.

Conclusion

56.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

    -Weisberg et al. (6,351,736), system and method for displaying advertisements

with played data.

    -Armstron et al. (7,017,173), system enabling user access to secondary content

associated with a primary content stream.

-Jeannin et al. (US 7,333,712), visual summary for scanning forwards and backwards in video content.

57.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY A. DISTEFANO whose telephone number is (571)270-1644. The examiner can normally be reached on Monday through Friday, 9 a.m. - 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on (571) 272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GREGORY A DISTEFANO/
Examiner, Art Unit 2175
5/11/2009

                                        /WILLIAM L. BASHORE/
                                        Supervisory Patent Examiner, Art Unit 2175